



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/242,828	02/24/99	SHIMIZU	S 102761

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EXAMINER

NAKARANI, D

ART UNIT

PAPER NUMBER

1773

DATE MAILED:

07/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/242,828

Applicant(s)

Shimizu et al

Examiner

D. S. Nakarani

Group Art Unit

1773



☒ Responsive to communication(s) filed on Feb 24, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-7 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1773

(1) The disclosure is objected to because of the following informalities: page 1, line 25, the phrase "adhesiveness at" should read -- adhesiveness of --, page 2, line 18, the phrase "(meta) acrylic acid" should read -- (metha) acrylic acid., page 3 line 23, the word "wetted" should read - - wet-- etc. Applicants are requested to review entire application for additional errors and also for proper idiomatic English.

Appropriate correction is required.

(2) The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

(3) Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specifications as filed fail to describe how to replace triple bonded carbon atoms in the acetylene glycol with a hydroxyl group and methyl group.

(4) Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an aqueous emulsion of polyurethane wherein the polyurethane has a glass transition- temperature between 40 and 150°C, does not reasonably provide enablement for generically claimed water polyurethane. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The invention as claimed is broader in scope

Art Unit: 1773

because the water polyurethane includes water soluble polyurethane and also any polyurethane which is water dispersible and having glass transition temperature below 40°C which will results in blocking film and when glass transition temperature is higher than the polyamide stretching temperature may not form film (see page 5, lines 1-13).

(5) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(6) Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because as it is written is not a single sentence, therefore cannot be understood;

line 4, the word "weiter" should read -- water--.

lines 6-7 the phrase "a coating amount between 0.005 and 0.030 g/m²" renders claims indefinite. It is not clear whether the claimed coating amount is based on dry weight or on wet weight.

Line 7 the "." (period) should be changed to --;-- (comma).

Line 8, the phrase "A. water polyurethane" should read -- A) an aqueous dispersion of polyurethane--.

Art Unit: 1773

Lines 8-10, the phrase “acetylene glycol in which two adjacent triple-bonded carbon atoms are replaced with a hydroxyl group and a methyl group” can not be understood. The examiner is unable to understand the compound after replacing two triple bonded carbon atoms of acetylene glycol (i.e. $\text{HO-C}\equiv\text{C-OH}$) with a hydroxy group and a methyl group. Applicants are requested to provide structure of such compound and/or clarification.

Line 12, the “B. A water-soluble polyepoxy compound “ should read ..B) a water-soluble polyepoxy compound” should read -- B) a water-soluble polyepoxy compound, --, and

Line 13, the phrase “C. Particles” should read -- C) particles-- and also the -- . -- (period) should be inserted at the end of line.

Claim 2, line 2, the phrase “containing an” should read -- wherein the non-ionic-- . Also the phrase “at a ratio between 0.01-1.0%” cannot be understood since ratios are dimensionless numbers.

Line 3, the --.-- period should be inserted at the end of line.

The phrase “easily adhesive” renders all claims indefinite. What is meant by “easily adhesive”. What is considered “easily adhesive”?

In claims 2, 3, and 5, line 1, the “An” should be changed to -- The--.

In claims 4, 6, and 7, line 1, the phrase “A compounded film” renders claims indefinite. It is not clear what is meant by “A compounded film” Applicants are trying to claim “a laminate”. Clarification and/or correction requested.

Art Unit: 1773

The phrase "other layers" renders claims 4, 6 and 7 indefinite. What kind of "other layers". What is encompassed by "other layers".

Claim 3, line 2, the phrase "coated with between 0.010 and 0.025 g/m² of coating agent" cannot be understood since it is not clear whether claimed amount is on dry base or on wet base? Also the -- . -- (period) should be inserted at the end of the claims 3 and 4.

Claim 5, lines 1-2, the phrase "coated with between 0.010 and 0.025 g/m² of coating agent" renders claim indefinite. Since it is not clear whether the claimed amount is on dry base or on wet base?

(7) Receipt of Information Disclosure Statement filed May 5, 1999 is acknowledged.

Japanese references 1-3 recited on PTOL 1449 have been considered to the extent of category shown on the foreign search report and Japanese references 4-7 have been considered to the extent of description provided in the instant application.

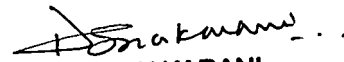
(8) The closest prior art U.S. Patent 5,952,106 to Schriver et al teach nylon film coated with a composition comprising (a) an aqueous dispersion of polyurethane (b) surfactant, © crosslinking agent and (d) a particulate material . Schriver et al. fail to teach a water soluble polyepoxy compound as cross-linking agent. Therefore in absence of such teaching claims are deemed allowable.

(9) Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (703) 308-2413. The examiner can normally be reached on Tuesday-Friday from 7:00 a.m. to 5:30 p.m.

Art Unit: 1773

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Paul J. Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718 or 305-3601.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


D. S. NAKARANI
PRIMARY EXAMINER

D. Nakarani/vr

07-05-00